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Paper No. 8

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OFFICE OF PETITIONS

In re Application of :
Igor Anatolievich Abrosimov :
Application No. 10/090,815 : DECSION ON PETITION
Filed: March 6, 2002 :
Attorney Docket No.: 2302 :
Title: TIMING DELAY GENERATOR AND :
METHOD USING TEMPERATURE :
STABILISATION :
:

This is a decision on the petition filed February 24, 2004, pursuant to 37 C.F.R. §1.137(a)¹, to revive the above-identified application.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Missing Parts (first notice²), mailed April 8, 2002, which set a shortened statutory period for reply of two (2) months.

On July 11, 2002, a one-month extension of time was received, along with the required fees. However, a new oath or declaration was not included. As such, a Notice of Incomplete Reply – Nonprovisional (second notice) was mailed on July 30, 2002. The second notice did not extend the period for response.

¹ A grantable petition pursuant to 37 CFR §1.137(a) must be accompanied by:

- (1) the required reply (in a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof);
- (2) the petition fee;
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and;
- (4) a terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

² The first notice indicated that the basic filing fee was insufficient (an additional \$15 was required), a late filing fee surcharge of \$65 was required, and the application appeared to have been filed without Figure 1.

No response was received, and no further extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on July 9, 2002. A Notice of Abandonment was mailed on January 21, 2004.

With the instant petition, Petitioner has supplied the petition fee, a declaration, a statement of facts, and a DHL mailing label.

Petition has met requirements (1) and (2) above. Requirement (4) does not apply.

Regarding the third requirement above, the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR §1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard

35 USC §133 states, “Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.” (emphasis added)

“In the specialized field of patent law, ... the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference.”³

The standard

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”⁴

The general question asked by the Office is: “Did petitioner act as a reasonable and prudent person in relation to his most important business?”⁵

³ Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA)1876 (D.D.C. 1990), aff’d without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) (“an agency’ interpretation of a statute it administers is entitled to deference”); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.”)

⁴ Id.

⁵ See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

Nonawareness of a PTO rule will not constitute unavoidable delay⁶

The burden of showing the cause of the delay is on the person seeking to revive the application⁷.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action⁸.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present⁹.

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account¹⁰."

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable"¹¹.

The regulations and portion of the MPEP relevant to the abandonment of this application

37 C.F.R. §1.4, entitled "Nature of correspondence and signature requirements," states, in part:

(a) Correspondence with the Patent and Trademark Office comprises:

(1) Correspondence relating to services and facilities of the Office, such as general inquiries, requests for publications supplied by the Office, orders for printed copies of patents or trademark registrations, orders for

⁶ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

⁷ Id.

⁸ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

⁹ In re Mattullath, 38 App. D.C. at (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

¹⁰ Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

¹¹ Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

copies of records, transmission of assignments for recording, and the like, and

(2) Correspondence in and relating to a particular application or other proceeding in the Office. See particularly the rules relating to the filing, processing, or other proceedings of national applications in subpart B, 37 C.F.R. §§ 1.31 to 1.378; of international applications in subpart C, 37 C.F.R. §§ 1.401 to 1.499; of *ex parte* reexaminations of patents in subpart D, 37 §§ 1.501 to 1.570; of interferences in subpart E, §§ 1.601 to 1.690; of extension of patent term in subpart F, 37 C.F.R. §§ 1.710 to 1.785; of *inter partes* reexaminations of patents in subpart H, 37 C.F.R. §§ 1.902 to 1.997; and of trademark applications 37 C.F.R. §§ 2.11 to 2.189.

(b) Since each file must be complete in itself, a separate copy of every paper to be filed in a patent or trademark application, patent file, trademark registration file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical. The filing of duplicate copies of correspondence in the file of an application, patent, trademark registration file, or other proceeding should be avoided, except in situations in which the Office requires the filing of duplicate copies. The Office may dispose of duplicate copies of correspondence in the file of an application, patent, trademark registration file, or other proceeding.

(c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

MPEP 501(III), entitled "Papers Received by Office of Initial Patent Examination", sets forth, in part:

Those who correspond with the USPTO are strongly encouraged not to include correspondence which will have to be directed to different areas (e.g., Patents and Trademarks) of the Office in a single envelope. Including multiple papers in a single envelope increases the likelihood that one or more of the papers will be delayed before reaching the appropriate area. Placing the papers in separately addressed envelopes will reduce the number of actions being performed by the USPTO unnecessarily or inappropriately.

MPEP 503, entitled "Application Number and Filing Receipt," states, in part:

RETURN POSTCARD

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

Application of the standard to the current facts and circumstances

Unfortunately, petitions filed under 37 C.F.R. §1.137(a) (where the cause of the abandonment is characterized as "unavoidable") have a very stringent standard associated with them.

With the instant petition, Petitioner has set forth that on July 30, 2002, a response was sent to the Office via DHL courier services. Petitioner states:

A response to the Notice of Incomplete reply of July 30, 2002 was sent by DHL courier services on August 23, 2002.

Please note that the package of the same date, i.e. of August 22, 2002 contained also a new US patent application, which was delivered on 28 August and accorded Serial number 10/229,082. We have a confirmation from the USPTO that these papers were received on August 28, 2002. So, we believe that the response was received too.

It is not clear what Petitioner means by "of the same date," as August 23, 2002 is not the same date as August 22, 2002. As the enclosed DHL label bears a date of "23/08/02," it is assumed that "August 22" is a typographical error.

It appears that the applicant enclosed both the required reply *and* a brand new patent application (which would later receive the serial number 10/229,082) in the same envelope.

It is possible that the response was assumed to be part of the new application. As set forth above, MPEP 501 advises Applicants against bundling separate matters together and mailing them in a single envelope so as to avoid this type of occurrence.

Since the Petitioner engaged in an activity which the MPEP explicitly recommends against, the delay was-perhaps unintentional but certainly not unavoidable.

Furthermore, the postcard receipt Petitioner has supplied does not constitute persuasive evidence pursuant to MPEP 503, as the declaration does appear as an itemized response. All it lists is a series of papers related to an entirely different application, Attorney Docket No. 3202CIP (which later received the serial number 10/229,082).

As such, the petition must be **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(a) must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.137(a) (and/or 37 C.F.R. §1.137(b)).", and should address only the deficiencies set forth above. This is **not** a final agency action within the meaning of 5 U.S.C 704.

Alternate venue

Petitioner may also wish to consider filing a petition under the unintentional standard, 37 CFR §1.378(b)¹². Petitioner should be made aware that although the surcharge is significantly higher (\$665.00 for a small entity), the standard associated with a petition filed under this section is far less stringent than the standard associated with a delay asserted to be "unavoidable". A form for this petition may be located at <http://www.uspto.gov/web/forms/sb0064.pdf>

12 A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

The reply to this letter may be submitted by mail¹³, hand-delivery¹⁴, or facsimile¹⁵.

The reply should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner. The Petitioner may wish to consider telephoning the undersigned at the number provided below to confirm that the documents were delivered to the undersigned. Please note that the delivery process within the PTO can take as much as three weeks.

The application file will be retained in the Office of Petitions for two (2) months.

Petitioner has also filed what appears to be an official Office form which he has altered, so as to bear the title "Petition for Requesting the Later Filing Date." Unfortunately, Petitioner has not set forth what filing date he wishes to receive. As such, the petition will not be worked on. On renewed petition, it is suggested that Petitioner clarify precisely what date he seeks.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.



Paul Shanoski
Attorney
Office of Petitions
United States Patent and Trademark Office

13 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

14 Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

15 (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned.